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EXAMINER

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/694,050
Filing Date: October 20, 2000
Appellant(s): WEINSTOCK ET AL.

Benjamin L. Volk, Jr.
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 1/31/08 appealing from the Office action mailed 4/5/07.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The following are the related appeals, interferences, and judicial proceedings known to the examiner which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal:

Case No. 1:07-cv-10302; currently pending with United States District Court for the District of Massachusetts.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

5,794,207	WALKER et al.	8-1998
6,125,384	BRANDT et al.	9-2000

5,182,705

BARR et al.

1-1993

Travel Agent, "Many Ways to Sell", Oct 2, 1995, Vol. 0, No. 0, p36

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 96-105, 107-127 and 131-136 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,794,207 to Walker et al. in view of "Many Ways to Sell" by Travel Agent in further view of U.S. Patent No. 6,125,384 to Brandt et al.

As per claim 96, Walker et al. teaches a method and apparatus for bilateral buyer-driven commerce comprising a seller interface (300, Fig. 1), central controller (200, Fig. 1) and buyer interface (400, Fig. 1) all connected via an Internet connection (see: column 11, lines 55-59). In addition, Walker et al teaches in box (515, Fig. 5), that a buyer logs on (reads on "access by an authorized purchaser computer via the Internet to provide a user of the authorized purchaser computer with an ability to book a rental vehicle reservation with any of a plurality of competitive rental vehicle service providers") to central controller to purchase for example, a rental car using an electronic form or contract, the form is displayed via the buyer interface (400, Fig. 1) (see: column 16, lines 15, line 60 to column 16, line 11). Walker et al. further teaches that the form is a conditional purchase offer (CPO), which

specifies the subject of the goods a person wishes to purchase, a description of the goods a person wishes to obtain, and any other conditions the buyer requires (see: column 8, lines 46-49). The CPO may be transcribed into digital text and made available to potential sellers ("plurality of competitive providers") (see: column 17, lines 7-19 and column 18, lines 15-21). Additionally, buyers are able to reach a large number of remotely located sellers (see: column 10, lines 40-43).

Walker fails to teach:

--the claimed GUI menus is configured to accept a selection by the user as to which one of the plurality of competitive rental vehicle service providers that a rental vehicle reservation is to be booked;

--the claimed computer network operated by the one the competitive rental service providers and the computer network comprising a mainframe that is configured to execute a rental vehicle software program;

--the claimed wherein at least one of the GUI menus is configured to interface a user of the authorized purchaser computer with the rental vehicle software program; and

--the claimed wherein the rental vehicle software program is configured to (1) automatically book, in response to input from the user, a rental vehicle reservation with the competitive rental vehicle service provider that operates the computer network without human intervention on the part of personnel of the competitive rental vehicle service provider that operates the computer network and (2) manage the booked rental vehicle reservation in response to input from the user.

Travel Agent teaches Enterprise Rent-a-Car 24-hour car reservation service that enables insurance adjusters to quickly secure a car for customers. Automated Rental Management System or ARMS, allows insurance companies to do business with Enterprise electronically, including making reservation, rental extensions, billing and payment (see: paragraph 2). The Examiner considers the 24-hour reservation service to be a mainframe that is configured to execute rental vehicle software and using a computer network operated by the one the competitive rental service providers.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include Enterprise Rent-a-Car 24-hour car reservation service as taught by Travel Agent within the bilateral buyer-driven commerce method for car rental as taught Walker et al. with the motivation of allowing authorized user to provide reliable and dependable service to customer involved in rental car insurance claim.

Walker et al. and Travel Agent fail to teach:

--the claimed GUI menus is configured to accept a selection by the user as to which one of the plurality of competitive rental vehicle service providers that a rental vehicle reservation is to be booked;

--the claimed computer network comprising a mainframe that is configured to execute a rental vehicle software program;

--the claimed wherein at least one of the GUI menus is configured to interface a user of the authorized purchaser computer with the rental vehicle software program; and

--the claimed wherein the rental vehicle software program is configured to (1) automatically book, in response to input from the user, a rental vehicle reservation with the

competitive rental vehicle service provider that operates the computer network without human intervention on the part of personnel of the competitive rental vehicle service provider that operates the computer network and (2) manage the booked rental vehicle reservation in response to input from the user.

Brandt et al. teaches FlowMark application software with purpose of renting a car that allows an authorized user to enter car rental information through a rental car agency's web site form (see: column 14, line 53 to column 15, line 37). Brandt et al. further teaches that the FlowMark application software outputs data container, which include car rental reservation information (see: column 14, lines 6-10 and 53-64). In addition, Brandt teaches that the car rental process model (440, Fig. 4) may model activity as a completely automatic process, which runs to completion without any human intervention (see: column 17, lines 28-58).

One of ordinary skill in the art at the time the invention was made would have found it obvious to include the automated process in the FlowMark application software for car rental within the Walker et al. and Travel Agent system with the motivation of providing a faster and more efficient way to process car rental application without any human intervention.

As per claim 97, Walker et al. teaches the claimed mainframe comprises a first mainframe, and wherein the computer network further comprises:

- a second mainframe in communication with the first mainframe;

- a database in which rental vehicle reservation data is stored, wherein the database is in communication with the second mainframe; and

a plurality of branch office computers of the competitive rental vehicle service provider that operates the computer network, wherein the plurality of branch office computers are in communication with the second mainframe; and

wherein the second mainframe is configured to execute a software program for access by the branch office computers to fulfill rental vehicle reservations that are stored within the database and that were booked and managed by the rental vehicle software program in response to input from the user. This limitation is met by the method and apparatus for bilateral buyer-driven commerce comprising a seller interface (300, Fig. 1), central controller (200, Fig. 1) and buyer interface (400, Fig. 1) all connected via an Internet connection (see: column 11, lines 55-59 and Fig. 1). In addition, each controller is attached to WAN hub that serves as the primary communication link for the interface devices (see: column 14, lines 31-41).

As per claim 98, Walker et al. teaches the claimed Internet web portal is further configured to transmit a rental vehicle reservation to a different one of the selected competitive rental vehicle service providers via email over the Internet. This feature is met by the network interface (245, Fig. 2) that is the gateway to communicate with the buyers and sellers (competitive rental vehicle service providers) via email over the Internet (see: column 14, lines 8-30).

As per claim 99, Walker et al. teaches the claimed Internet web portal is further configured to transmit a rental vehicle reservation to a different one of the selected competitive rental vehicle service providers via phone. This feature is met by the network interface (245, Fig. 2) that is the gateway to communicate with the buyers and sellers (competitive rental vehicle

service providers) via voice mail interface (see: column 14, lines 8-30 and column 9, lines 52-56).

As per claim 100, Walker et al. teaches the claimed Internet web portal is further configured to transmit a rental vehicle reservation to a different one of the selected competitive rental vehicle service providers via facsimile. This feature is met by the buyers and sellers communicating with the central controller via telephone and facsimile (see: column 14, lines 8-30 and column 9, lines 52-56).

As per claim 101, Walker et al. teaches the claimed second one of the computer networks, wherein the second one of the computer networks is operated by a different one of the competitive rental vehicle service providers. This limitation is met by a seller interface (300, Fig. 1) (see: column 11, lines 55-59). In addition, Walker et al teaches a conditional purchase offer (CPO), which specifies the subject of the goods a person wishes to purchase, a description of the goods a person wishes to obtain, and any other conditions the buyer requires (see: column 8, lines 46-49). The CPO may be transcribed into digital text and made available to potential sellers ("plurality of competitive providers") (see: column 17, lines 7-19 and column 18, lines 15-21).

As per claim 102, Brandt et al. teach the claimed Internet web portal is configured for access by a plurality of authorized purchaser computers, and wherein the Internet web portal is further configured to customize the GUI menus on a per authorized purchaser computer user basis. This limitation is met by the FlowMark application software with purpose of renting a car that allows an authorized user to enter car rental information through a rental car agency's web site form (see: column 14, line 53 to column 15, line 37).

As per claim 103, Brandt et al. teach the claimed Internet web portal is configured to provide a user of the authorized purchaser computer with a single set of GUI menus for booking a rental vehicle reservation with all of the competitive rental vehicle service providers. This limitation is met by the FlowMark application software with purpose of renting a car that allows an authorized user to enter car rental information through a rental car agency's web site form (see: column 14, line 53 to column 15, line 37).

As per claim 104, Brandt et al. teach the claimed Internet web portal is further configured to accommodate a plurality of varying data requirements for rental vehicle reservations with the competitive rental vehicle service providers. This limitation is met by the FlowMark application software with purpose of renting a car that allows an authorized user to enter car rental information through a rental car agency's web site form (see: column 14, line 53 to column 15, line 37).

As per claim 105, Travel Agent teaches the claimed rental vehicle software program is further configured to support a plurality of management functions by the user for a rental vehicle reservation, the management functions comprising a rental vehicle reservation extension by the user, an authorization by the user of a request for a rental vehicle reservation extension requested by someone other than the user, an authorization by the user for a rental vehicle reservation booked by someone other than the user, and a change in rental vehicle reservation authorization by the user (see: paragraph 2).

As per claims 128-130, they are rejected for the same reason set forth in claims 106-108.

As per claims 109-112, Walker et al. teaches at step 500, buyer logs on the central controller (200, Fig. 2) using buyer modem (450, Fig. 1) at step 500 (see: column 15, lines 60-

65) and seller logs onto central controller (200, Fig. 1) using modem (350, Fig. 1) at step 900 (see: column 18, lines 56-59). Walker et al. also teaches several servers working in conjunction with buyer interface (400, Fig. 1) and seller interface (300, Fig. 1) (see: column 27, lines 25-30). In addition, Walker et al. teaches a method and apparatus for bilateral buyer-driven commerce comprising a seller interface (300, Fig. 1), central controller (200, Fig. 1) and buyer interface (400, Fig. 1) all connected via an Internet connection (see: column 11, lines 55-59). Walker et al. further teaches that the form is a conditional purchase offer (CPO), which specifies the subject of the goods a person wishes to purchase, a description of the goods a person wishes to obtain, and any other conditions the buyer requires (see: column 8, lines 46-49). The CPO may be transcribed into digital text and made available to potential sellers ("plurality of competitive providers") (see: column 17, lines 7-19 and column 18, lines 15-21). Additionally, buyers are able to reach a large number of remotely located sellers (see: column 10, lines 40-43).

As per claim 113, it is rejected for the same reason set forth in claim 96.

As per claims 114-117, Travel Agent teaches Enterprise Rent-a-Car 24-hour car reservation service that enables insurance adjusters to quickly secure a car for customers. Automated Rental Management System or ARMS, allows insurance companies to do business with Enterprise electronically, including making reservation, rental extensions, billing and payment (see: paragraph 2). The Examiner considers that an insurance adjuster (reads on "business organization comprises an insurance company") extending a rental to include a replacement rental vehicle reservation on behalf of a plurality of third party renters.

As per claims 118-126 and 131-136, they are rejected for the same reasons set forth in claims 97-100, 97, 102, 116, 103-105, 109-110, 109, 112, 109, respectively.

7. Claims 106-108 and 128-130 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,794,207 to Walker et al., "Many Ways to Sell" by Travel Agent and U.S. Patent No. 6,125,384 to Brandt et al. as applied to claims 97 and 105 above, and further in view of U.S. Patent No. 5,182,705 to Barr et al.

Walker et al., Travel Agent and Brandt et al. teach the FlowMark application software with purpose of renting a car that allows an authorized user to enter car rental information through a rental car agency's web site form (see: Brandt et al.: column 14, line 53 to column 15, line 37).

Walker et al., Travel Agent and Brandt et al. fail to teach

--the claimed create a plurality of workgroups of users, wherein each workgroup shares a workload of management function actions;

--the claimed assigning each user of the authorized purchaser computers with an authorization limit; and

--the claimed authorization limit includes a financial commitment dollar limit that a user can make over a specified time period.

Barr et al. teaches an automated work management system used to process an insurance claims (see: column 3, lines 5-11 and 28-42). In addition, Barr et al. teaches a Staff Table function that provides an online record for each member of the claim staff and authority level and caseload limits of each staff member are set by supervisors with appropriate authority and entered into the Staff Tables. These records can be modified, deleted or added as necessary (see: column 7, lines 3-16). Barr et al. further teaches a security system called MENUTECH® which assigns security levels to each employee by giving them a User ID and a password. When an

employee using the computer stations (32, 34, 36 Fig. 5) wishes to use the system, he must “Log On” using his User ID and a password, and if correctly entered a Main Menu screen for the operator’s appropriate security level displayed (see: column 10, lines 44 to column 11, lines 1). Additionally, Barr et al. teaches a Staff Tables function that maintains information relevant to the claim office personnel such as authority level, case load maximum, job title, etc. for each staff member. Supervisors determine the proper reserve authority level, payment authority level, diary limit, case load amount, etc. for each staff member (see: column 29, lines 1-11 and column 31, lines 24-65 and Table XXVI).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include assigning authorization limit as taught by Barr et al. with the system as taught by Walker et al., Travel Agent and Brandt et al. with the motivation of reducing paper intensity in the maintenance of records in processing claims (see: Barr et al.: column 3, lines 1-2).

(10) Response to Argument

In the Appeal Brief filed 31 January 2008, Appellant makes the following arguments:

(A) The Examiner in rejecting claim 96 for obviousness based on the combination of the Walker, “Many Ways to Sell”, and Brandt references because the Examiner has failed to set forth a valid reasons for combining the Walker reference with the “Many Ways to Sell” reference.

(B) Walker, “Many Ways to Sell”, and Brandt references fail to teach or suggest both (1) the limitation in claim 96 which requires that rental vehicle reservation be created “automatically” and “without human intervention on the part of personnel of the competitive

rental vehicle service provider”, and (2) the limitation in claim 96 which requires that the user be given the ability to make “a selection...as to which one of the plurality of competitive rental vehicle service providers that a rental vehicle reservation is to be booked with”.

(C) Examiner has failed to explain how the cited references render obvious the concept of making two computer networks available to user through a common Internet web portal as recited in claim 101.

(D) Examiner fails to show how the recited features of GUI menu customization on a “per authorized purchaser computer basis” or a “per user basis” as recited in claims 102 and 123.

(E) Examiner has pointed to no rationale for extending Brandt’s “rental reservation form” for use with a plurality of different competitive rental agencies as recited in claim 103.

(F) Examiner has failed to explain how Barr discloses the concept of a workload of management functions that are shared by a plurality of users such as claims adjusters as recited in claim 106.

(G) The Barr reference fail to teach concept of imposing a financial commitment dollar limit that a user can make on rental vehicle reservations over a specified time period as recited in claim 128.

Examiner will address Appellant’s arguments in sequence as they appear in the brief.

Response to Arguments (A) and (B):

In response to the first and second argument, the Examiner respectfully submit that one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). In addition, the test for

obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

In addition, it respectfully submitted that the Walker et al. and Travel Agent references, and not Brandt et al., *per se*, that was relied upon for the specific teaching of an electronic form or contract for a renting a car, the form is a conditional purchase offer (CPO), which specifies the subject of the goods a person wishes to purchase, a description of the goods a person wishes to obtain, and any other conditions the buyer requires (see: column 8, lines 46-49 and column 16, lines 15, line 60 to column 16, line 11). The CPO may be transcribed into digital text and made available to **potential sellers** ("**plurality of competitive providers**") (see: Walker et al.: column 17, lines 7-19 and column 18, lines 15-21). Additionally, buyers are able to reach a large number of remotely located sellers (see: column 10, lines 40-43). Walker et al. also teaches that communication between the buyer and seller take place via electronic network (see: column 15, lines 45-48). Travel Agent teaches a 24-hour car reservation service that enables insurance adjusters to quickly secure a car for customers. Automated Rental Management System or ARMS, allows insurance companies to do business with Enterprise electronically (reads on "inter-company data communication"), including making reservation, rental extensions, billing and payment (see: paragraph 2). Brandt et al. was relied for primarily teaching FlowMark application software with the purpose of renting a car that allows an authorized user to enter car rental information through a rental car agency's web site form (see: column 14, line 53 to

column 15, line 37). Brandt et al. further teaches that the FlowMark application software outputs data container, which include car rental reservation information (see: column 14, lines 6-10 and 53-64). In addition, Brandt teaches that the car rental process model (440, Fig. 4) may model activity as a completely automatic process, which runs to completion without any human intervention (see: column 17, lines 28-58). Thus, the proper combination of the applied references would be the incorporation of Brandt's automated process in the FlowMark application software for car rental with the system described by Walker et al. and Travel Agent using inter-company data communications.

Furthermore, it is respectfully submitted that the key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. The Supreme Court in *KSR* noted that the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit. The Court quoting *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006), stated that “[R]ejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *KSR*, 550 U.S. at ___, 82 USPQ2d at 1396. An example of rationale that may support a conclusion of obviousness include: (G) Some teaching, suggestion, or motivation in the prior art that would have led one of ordinary skill to modify the prior art reference or to combine prior art reference teachings to arrive at the claimed invention See MPEP § 2143. Furthermore, if the search of the prior art and the resolution of the *Graham* factual inquiries reveal that an obviousness rejection may be made using the familiar teaching-suggestion-motivation (TSM) rationale, then such a rejection should be made. Although the Supreme Court in *KSR* cautioned against an overly rigid application of

TSM, it also recognized that TSM was one of a number of valid rationales that could be used to determine obviousness. (According to the Supreme Court, establishment of the TSM approach to the question of obviousness “captured a helpful insight.” 550 U.S. at ___, 82 USPQ2d at 1396 (citing *In re Bergel*, 292 F.2d 955, 956-57, 130 USPQ 206, 207-208 (1961))).

Response to Argument (C):

In response to the third argument, the Examiner respectfully submits that Walker teaches a seller interface (300, Fig. 1) (see: column 11, lines 55-59). In addition, Walker et al teaches a conditional purchase offer (CPO), which specifies the subject of the goods a person wishes to purchase, a description of the goods a person wishes to obtain, and any other conditions the buyer requires (see: column 8, lines 46-49). The CPO may be transcribed into digital text and made available to potential **sellers** (“plurality of competitive providers”) (see: column 17, lines 7-19 and column 18, lines 15-21). Furthermore, Walker et al. teaches a method and apparatus for bilateral buyer-driven commerce comprising a seller interface (300, Fig. 1), central controller (200, Fig. 1) and buyer interface (400, Fig. 1) all connected via an Internet connection (see: column 11, lines 55-59). This clearly shows that computer network including a number of sellers using a seller interface (another user) participate in the rental vehicle reservation process.

Response to Arguments (D) and (E):

In response to the fourth and fifth argument, the Examiner respectfully submit that Brandt et al. teaches the FlowMark application software with purpose of renting a car that allows an authorized user to enter car rental information through a rental car agency’s web site form (see: column 14, line 53 to column 15, line 37). The Brandt reference indicates that authorized user for

example; using a password can access and use the system via the Internet according to their password privileges (customized per user).

Response to Arguments (F) and (G):

In response to the sixth and seventh argument, the Examiner respectfully submits that the Barr et al. reference teaches an automated work management system used to process insurance claims (see: column 3, lines 5-11 and 28-42). In addition, Barr et al. teaches a Staff Table function that provides an online record for each member of the claim staff and authority level and caseload limits of each staff member are set by supervisors with appropriate authority and entered into the Staff Tables. These records can be modified, deleted or added as necessary (see: column 7, lines 3-16). Barr et al. further teaches a security system called MENUTECH® which assigns security levels to each employee by giving them a User ID and a password. When an employee using the computer stations (32, 34, 36 Fig. 5) wishes to use the system, he must “Log On” using his User ID and a password, and if correctly entered a Main Menu screen for the operator's appropriate security level displayed (see: column 10, lines 44 to column 11, lines 1). Additionally, Barr et al. teaches a Staff Tables function that maintains information relevant to the claim office personnel such as authority level, case load maximum, job title, etc. for each staff member. Supervisors determine the proper reserve authority level, payment authority level, diary limit, case load amount, etc. for each staff member (see: column 29, lines 1-11 and column 31, lines 24-65 and Table XXVI). This clearly describes that staff members share responsibilities according to their authorization level and caseload limits. Furthermore, the supervisors can determine the payment (financial commitment dollar limit) authority level for each staff member and can modified, deleted or added responsibilities as necessary.

Art Unit: 3600

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

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